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EXAMINER

MCEVOY, THOMAS M

ART UNIT	PAPER NUMBER
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3731

NOTIFICATION DATE	DELIVERY MODE
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ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary	Application No. 10/539,255	Applicant(s) GLAESEL, JORGEN	
	Examiner THOMAS MCEVOY	Art Unit 3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 September 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5,8,9 and 11-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5,8,9 and 11-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 1-5, 8, 9 and 11-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Browne (US 549,895) in view of Gobeil et al. (US 5,884,900) and Graue (US 1,101,845).

Regarding claims 1 and 8, Browne discloses a tool capable of removing ticks and other like parasites from the skin (a tack shank can be comparable in size to a tick), which tool has an engagement part ($a/a'/a^2$) with a bottom face and a top face (Figure 4), wherein a V-shaped groove (Figure 3) is provided that has side faces (Figure 2) between the bottom face and the top face at an edge (Figure 4; perpendicular to concave side faces) of the engagement part, which side edges converge towards each other from an outer opening at the edge towards an internal assembly point a^2 , said V-

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shaped groove being wider at the top face of the engagement part than it is at the underside (Figure 4), characterised in that a considerable portion of each side face of the V-shaped groove between the underside and the top face of the engagement part is constituted by a concave engagement face (Figure 4). At the bottom of the V-shaped groove, at a² of Figure 2, what can be regarded as a cutter blade is provided in level with the bottom face (see line 88). Browne fails to disclose the blade thickness as claimed. Gobeil et al. teach that the thickness of a fastener remover should be less than the length of a tick head (see attached references cited in previous office action) in order to wedge the device under the top of the fastener (col. 2, lines 65-67; Figures 4-6). Therefore, it would have been obvious to one of ordinary skill in the art in view of Gobeil et al. to have constructed all portions of the Browne device that are intended to wedge under a tack head with the claimed thickness. This would include the bottom of the V-shaped groove. Browne further discloses each side face comprises a lowermost part (Figure 4; wall between side face and bottom face) that extends essentially perpendicularly from the bottom face and is connected to the concave engagement face. Browne in view of Gobeil et al. does not disclose that the lowermost part of the side faces is increasing in height as claimed. Graue discloses a tack puller which has side faces which increase in height (at item 6, Figures 1 and 3; lines 60-65). It would have been obvious to one of ordinary skill in the art in view of Graue to have increased the height of the Browne lowermost part as claimed because one of ordinary skill in the art would recognize that the tapering in height of Graue's V-shaped groove assists in wedging the tool under a tack. Examiner further contends that tapering the height of a

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v-shaped groove is old and well known in the art in order to wedge a tack or nail puller under a tack or nail head as evidenced by at least Benitez et al. (cited previously; additional references can be provided). Regarding claim 2, a lowermost part of the concave engagement face is essentially in parallel with the bottom face (Figure 4). Regarding claims 3-5, the concave face can be regarded in the claimed manners. Regarding claim 9, an innermost part of the lowermost part of the side face is provided with parallel side faces (Figure 4). Regarding claim 11, the tool comprises a holder part C' provided with an upwardly protruding transverse beam B for supporting a thumb. Regarding claim 12, the tool comprises a holder part C' provided with an indentation (at C', Figure 1) for supporting a thumb. Regarding claim 14, $a/a'/a_2$ forms a recess that can support a finger. Regarding claims 13 and 17, Browne discloses the device as described above but fails to disclose ribs on the handle. However, it is well-known in the art to provide ribs on the handles hand tools to provide gripping support. It would therefore have been obvious to one of ordinary skill in the art to have provided a ribbed area on the handle of Browne to provide gripping support. Browne fails to disclose that the overall length (or the largest outer dimension) corresponds essentially to the dimensions of a credit card (3-4 inches). However, it is well-known in the art that small, hand-held prying instruments of this nature can have overall lengths of 3-4 inches (see References Cited). It would therefore have been obvious to one of ordinary skill in the art to have constructed the device with this overall length as an obvious matter of design choice. Since Applicant failed to traverse Examiner's assertions, the above well-known in the art statements (for claims 1, 13 and 17) are taken to be admitted prior art

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(MPEP 2144.03 C). Regarding claim 15, part C of the tool is plate shaped. Regarding claim 16, at least one recess is provided in the area between the engagement part and the holder part (lines 77-83).

4. Claims 2-5, 9 and 11-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Browne (US 549,895) in view of Gobeil et al. (US 5,884,900) and Cardozo (GB 2,226,974).

Regarding claims 2-5, 9 and 11-17, Browne in view of Gobeil et al. disclose the tool as described above but fail to disclose that the lowermost part of each side face is increasing in height, as seen from the edge to the internal assembly point. Cardozo teaches that a tack puller should have a side face that increases in height (at 8) as claimed in order to provide a proximal portion of the puller with extra strength (page 2, lines 8-9). It would have been obvious to one of ordinary skill in the art in view of Cardozo to have increased the height of the lowermost part of Browne as claimed in order to provide more strength. One of ordinary skill in the art would recognize the benefit of having greater strength closer towards the pivot point where upward pressure on the tack is applied.

Response to Arguments

5. Applicant's arguments filed November 19th 2010 have been fully considered but are not persuasive. Applicant has argued that one of ordinary skill in the art, in light of Applicant's specification would understand that "a size of a head of a tick" is referring to the thickness of a tick head. Although this argument is not persuasive, after further consideration, the rejection is withdrawn because the specification makes clear that the

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limitation is referring to a dimension (i.e. length, width, height, thickness, etc.) of a tick head. The claim limitation has been given this broad interpretation. Applicant has argued that it is unclear whether the evidence cited in the previous office action is a part of the grounds of rejection or not. Examiner has cited this art as evidence that the thicknesses disclosed by Gobeil et al. are less than a size of a tick head. These references are not part of the grounds of rejection. Applicant has argued that it is improper to combine Gobeil et al. with Browne because Gobeil et al. disclose that tack pullers are incompatible with pulling snap fasteners from aircraft. It is clear from the disclosure of Gobeil et al. that their invention is not in any way limited to snap fasteners and is intended for fasteners in general such as nails (col. 1, lines 4-6; Figures 4-6). Furthermore, the teaching that nail pullers are inappropriate for use with aircraft snap fasteners in no way detracts from the teaching of providing a thickness less than the protruding height of a fastener head.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas McEvoy whose telephone number is (571)270-5034. The examiner can normally be reached on M-F, 9:00-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan Nguyen can be reached on 571-272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

8. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Thomas Mcevoy/
Examiner, Art Unit 3731

/(Jackie) Tan-Uyen T. Ho/
Supervisory Patent Examiner, Art Unit 3773

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